

Application No. : 10/639,070
Filed : August 12, 2003

REMARKS

Claims 1-22, 28-49 and 55-65 were pending in the application. By this paper, Applicant amended Claims 1, 28, 36, 42-45, and 65 and added new Claims 66-73. Accordingly, Claims 1-22, 28-49 and 55-73 are presented for examination herein.

§103 Rejections

1. Per page 2 of the Office Action, Claims 1-8, 28-40, 42-43, 46-49, and 55-64 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering, et al. (U.S. Patent Publication No. 2002/0144263; hereinafter referred to as “Eldering”) in view of Herz, et al. (U.S. Patent No. 5,758,257; hereinafter referred to as “Herz”). In response hereto, Applicant provides the following remarks.

Claims 1 and 28 – Applicant respectfully traverses the Examiner’s §103 rejection of Claims 1 and 28 as being unpatentable over Eldering in view of Herz.

Applicant notes that “*To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.*” *In re Royka*, 490 F.2d 981 (CCPA 1974). See MPEP 2143.03.

The Examiner contends that Herz discloses “*scrutinizing a list of viewers currently viewing a program stream based on their appetite for the content which meets ‘generating a list of individual ones of the plurality of user terminals currently receiving the programming content’ (column 26, 18-19) and is exhibited in figure 2, label 212...*”. Applicant disagrees.

Applicant submits that Herz does not teach or suggest generating a list of individual ones of a plurality of user terminals (or an audience) currently receiving the programming content as recited in Claims 1 and 28. Rather, at col. 26, lines 18-19, Herz merely discloses “*At step 212, those with no appetites (channels for scheduling) left are removed from the scheduling list.*” In other words, Herz discloses creating a list of customers who have channels left to schedule (i.e., who have an appetite). Per col. 26, lines 18-19, once a customer has received the desired channel (i.e., no longer has an appetite) the customer is *removed* from the list.

Hence, Applicant submits that the scheduling list disclosed in Herz comprises only a list of customers who have not yet received programming content, and not a list of customers

Application No. : 10/639,070
Filed : August 12, 2003

currently receiving programming content as recited in Claims 1 and 28 (as those customers will have been removed from the list because they no longer have “appetites”).

However, in order to more clearly distinguish the invention of Claims 1 and 28 Applicant has, by this paper, amended Claims 1 and 28 to recite “providing at least one programming segment in lieu of at least a portion of the programming content”. Support for this amendment may be found at, *inter alia*, the last paragraph of page 18 to the second paragraph of page 19 of Applicant’s specification as filed.

Applicant respectfully submits none of the prior art cited by the Examiner, including Eldering and/or Herz, teaches or suggests the aforementioned limitation. For example, at paragraph [0089] Eldering merely discloses “*advertisement insertion module 904 requests the appropriate advertisement from the advertisement storage unit 914 which then sends the advertisement to the insertion module 904. The advertisement insertion module then inserts the advertisement with the proper timing.*” In other words, Eldering discloses, inserting an advertisement into program content. There is no mention in Eldering that the advertisements are inserted in lieu of a portion of the programming content; rather, the advertisements are simply spliced into the programming content at an appropriate location. Accordingly, Eldering does not teach or suggest providing at least one programming segment in lieu of at least a portion of the programming content.

Therefore, Applicant respectfully submits that Claims 1 and 28 distinguish over the art of record including Eldering and Herz, and thus are not rendered unpatentable thereby.

Claim 36 – Applicant respectfully traverses the Examiner’s §103 rejection of Claim 36 as being unpatentable over Eldering in view of Herz.

The Examiner argues that Eldering discloses at paragraph [0089] “*a server for generating one or more data streams containing one or more alternate programming segment for substituting the scheduled programming segment*”. Applicant disagrees.

Applicant submits that Eldering does not teach or suggest the aforementioned limitation. Rather, Eldering at paragraph [0089] merely discloses inserting an advertisement into program content. As illustrated in Fig. 9, the Eldering system comprises determining where there is an opening for advertisements, and inserting an advertisement therein (the advertisements being different for the different groups of customers). In other words, an advertisement is incorporated

Application No. : 10/639,070
Filed : August 12, 2003

into the scheduled programming. However, Eldering does not disclose the scheduled programming being *substituted* for a different segment. The advertisements are incorporated directly into the scheduled programming, without substitution. Thus, Eldering does not teach or suggest a server for generating one or more data streams containing one or more alternate programming segment for substituting the scheduled programming segment as recited in Claim 36.

The Examiner further argues that Herz discloses “*scrutinizing a list of viewers currently viewing a program stream based on their appetite for the content which meets ‘identifying a set of one or more user terminals which is currently receiving the program stream, one or more groups of user terminals within the set being identified’ (column 26, 18-19) and is exhibited in figure 2, label 212.*” Applicant disagrees.

Applicant submits that Herz does not teach or suggest (i) identifying a set of one or more user terminals which is currently receiving the program stream, or (ii) identify one or more groups of user terminals within the set being identified in (i) above. Specifically, Applicant submits that Herz does not disclose identifying a set of user terminals *currently receiving* the program stream; rather, at col. 26, lines 18-19, Herz discloses creating a list of customers who have channels left to schedule (i.e., who have an appetite). Customers who have received the desired channel (i.e., no longer have an appetite) are *removed* from the list of Herz. Thus, the scheduling list disclosed in Herz identifies a set of customers who have not yet received a given program stream, and does not identify customers currently receiving the program stream. Those customers who are currently receiving the program stream will have been removed from the list for no longer having an appetite.

Further, even if one were to assume *arguendo*, that Herz discloses identifying a set of one or more user terminals currently receiving the program stream as in (i) above, Applicant submits that Herz does not disclose further identifying one or more groups of user terminals within the set of users currently receiving the stream.

However, to more clearly distinguish Claim 36 over Herz, Applicant has herein amended Claim 36 to recite grouping the identified set of one or more terminals into one or more groups based on at least one characteristic. Support for this amendment is replete throughout Applicant’s specification as filed, including at *inter alia*, the last paragraph of page 15 of the specification as filed. Neither Eldering nor Herz teaches or suggests such limitations, and in fact teaches away

Application No. : 10/639,070
Filed : August 12, 2003

from Applicant's invention of Claim 36, since Herz affirmatively teaches removal of terminals receiving a given program stream from a population (thereby completely frustrating any further "grouping" thereof as now recited in Claim 36).

Therefore, Applicant submits that Claim 36 as amended distinguishes over the art of record including Eldering and Herz, and is not rendered obvious thereby.

Claims 55 and 60 – Applicant respectfully traverses the Examiner's §103 rejection of Claims 55 and 60 as being unpatentable over Eldering in view of Herz.

The Examiner contends that Eldering discloses "*providing, over the allocated one or more transmission channels, the at least one advertisement data stream which contains one or more advertisements targeted at a selected group of the set of the plurality of users, in lieu of providing the advertising segment within the programming content (figure 6 labels 603, 605, & 607 & figure 4).*" Applicant disagrees.

Applicant submits that Eldering does not teach or suggest the aforementioned limitation. At Fig. 6, Eldering illustrates an exemplary GROUP-VPI/VCI table. Per paragraph [0065], the GROUP-VPI/VCI table is used to associate an STB with a group of advertisements. The GROUP-VPI/VCI table comprises a MAC_ID column 603, an advertisement group column 605, and a corresponding VPI/VCI column 607. Further, at Fig. 4, Eldering illustrates an exemplary time-division multiplexing (TDM) channel. The TDM channel, per paragraph [0055] is the channel by which the STB receive a multiplex of the various groups of advertisements. Neither Fig. 6 nor Fig. 4 illustrates providing one or more advertisements targeted at a selected group of the set of the plurality of users, in lieu of providing the advertising segment within the programming content. Rather, in Eldering, advertising segments are spliced directly into programming content (see e.g., paragraph [0089]) and are not provided in lieu of other segments within the programming content.

The Examiner further contends that Herz discloses "*scrutinizing a list of viewers currently viewing a program stream based on their appetite for the content which meets 'deriving [or generating] a list of a set of the plurality of users which are receiving the programming content during the scheduled presentation of the programming content' (column 26, 18-19) and is exhibited in figure 2, label 212.*" Applicant disagrees.

Application No. : 10/639,070
Filed : August 12, 2003

Applicant respectfully submits that Herz does not teach or suggest deriving or generating a list of a set of the plurality of users which are receiving the programming content during the scheduled presentation of the programming content as recited in Claims 55 and 60. Rather, at column 26, lines 18-19 Herz merely discloses updating a list of customers having channels left to schedule. In other words, in Herz a list is kept of customers who are *requesting* programming (i.e., having an appetite). As the customer's receive the desired programming, they are removed from the list. Thus, Herz does not disclose maintaining a list of the customers which are receiving the programming content, as these customers are promptly removed from the list in Herz for no longer having an appetite.

Since the prior art, including Eldering and Herz, do not teach or suggest all of the limitations of Applicant's Claims 55 and 60 (whether taken alone or in combination), Applicant submits that Claims 55 and 60 are not rendered unpatentable thereby.

2. Per page 11 of the Office Action, Claims 9-13, 15-16, 20-22, and 65 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering in view of Dimitrova, et al. (U.S. Patent Publication No. 2003/0093784; hereinafter referred to as "Dimitrova") in view of Herz. In response thereto Applicant provides the following.

Claims 9 and 65 – Applicant respectfully traverses the Examiner's §103 rejection of Claim 9 as being unpatentable over Eldering in view of Dimitrova in view of Herz.

The Examiner contends that Eldering discloses "*generating one or more data streams containing one or more alternate programming segment for substituting the scheduled programming segment (figure 5, whole system).*" Applicant disagrees.

Applicant submits that Eldering does not teach or suggest generating one or more data streams containing one or more alternate programming segments for substituting the scheduled programming segment as recited in Claims 9 and 65. Applicant submits that Fig. 5 illustrates a system for assigning a group of advertisements to a group of STBs using a map table (GROUP-VPI/VCI). Eldering does not disclose substituting an alternate programming segment for the scheduled programming segment. Rather, the system of Fig. 5 merely enables the STB to "tune" to the proper VPI/VCI (corresponding to the group of the STB) in order to receive ads appropriate for it (see e.g., paragraph [0065]). Once the appropriate advertisements are received,

Application No. : 10/639,070
Filed : August 12, 2003

per paragraph [0089], the advertisements are inserted into a program stream at the appropriate times. The appropriate advertisement segments are not substituted for scheduled segments in Eldering. Thus, Eldering does not disclose generating one or more data streams containing one or more alternate programming segments for substituting the scheduled programming segment.

5 The Examiner further contends that Herz discloses “*scrutinizing a list of viewers currently viewing a program stream based on their appetite for the content which meets ‘identifying one or more groups of user terminals within the set of user terminals currently receiving the program stream’ (column 26, 18-19) and is exhibited in figure 2, label 212: Herz teaches selecting most popular program from the list of programs to be transmitted after*
10 *scrutinizing the list....*” Applicant disagrees.

Applicant respectfully submits that Herz does not teach or suggest the aforementioned limitation of Claims 9 and 65. Rather, at column 26, lines 18-19 Herz merely discloses “*At step 212, those with no appetites (channels for scheduling) left are removed from the scheduling list.*” In other words, Herz discloses identifying customers who have channels left to schedule (i.e.,
15 who have an appetite) and not identifying customers currently receiving the program stream. Customers currently viewing a program stream are not kept in the scheduling list disclosed in Herz, as these customers no longer have an “appetite”.

Further, at column 25, line 66 – column 26, line 3, Herz discloses “*at step 204 the most popular programs for a single customer (at the set top multimedia terminal) or a cluster of*
20 *customers (at the head end) are selected and removed from the list of available programs during the relevant time interval.*” In other words, Herz merely discloses identifying popular programs within a group of available programs. Nowhere does Herz disclose identifying user terminals within the set of user terminals currently receiving a program stream.

Respectfully, none of the prior art cited by the Examiner, including Eldering, Dimitrova
25 and/or Herz, teaches or suggests all of the limitations of Claims 9 and 65. Hence these claims are not rendered obvious thereby.

3. Per page 16 of the Office Action, Claims 17-19 and 44-45 stand rejected under 35
U.S.C. 103(a) as being unpatentable over Eldering in view of Herz, in view of Eldering (U.S.
30 Patent No. 6,615,039; hereinafter referred to as “Eldering-2”).

Application No. : 10/639,070
Filed : August 12, 2003

Applicant respectfully submits that the Examiner's rejections of dependent Claims 17-19 and 44-45 are rendered moot, given the arguments and/or amendments discussed above with respect to independent Claims 9 and 36, respectively.

5 4. Per page 19 of the Office Action, Claim 14 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Eldering, in view of Dimitrova, in view of Herz, in view of Hendricks, et al. (U.S. Patent No. 6,463,585; hereinafter referred to as "Hendricks").

Applicant respectfully submits that the Examiner's rejection of dependent Claim 14 is rendered moot, given the arguments and/or amendments discussed above with respect to
10 independent Claim 9.

5. Per page 20 of the Office Action, Claim 41 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Eldering in view of Herz, in view of Hendricks.

Applicant respectfully submits that the Examiner's rejection of dependent Claim 41 is
15 rendered moot, given the arguments and/or amendments discussed above with respect to independent Claim 36.

New Claims

By this paper, Applicant has added new Claims 66-73.

20 Support for new dependent Claim 66 may be found at, *inter alia*, the last paragraph of page 12 to the first paragraph of page 13 of Applicant's specification as filed.

Support for new dependent Claim 67 is replete throughout Applicant's specification as filed, including at *inter alia*, the last paragraph of page 14 of Applicant's specification as filed.

25 New independent Claim 68 corresponds generally to certain aspects of the subject matter of previous independent Claims 50 and 60. Applicant notes that new independent Claim 68 recites a processing unit adapted to (i) ascertain the identity of individual ones of the plurality of users receiving the scheduled programming content, and (ii) categorize the individual ones of the plurality of users receiving the scheduled programming content into one or more groups.

Applicant respectfully submits that none of the prior art cited by the Examiner including
30 Eldering, Dimitrova and/or Herz discloses the aforementioned limitations. Specifically, Herz merely discloses identifying customers who have not yet received a selected channel and not

Application No. : 10/639,070
Filed : August 12, 2003

identifying customers currently receiving the program stream as those customers are not kept in the scheduling list disclosed in Herz (i.e., no longer have an appetite). Further, Applicant submits that none of the cited art teaches or suggests categorizing identified users into one or more groups, and in fact, Herz teaches away from such grouping.

5 Applicant also notes that new independent Claim 68 recites a mechanism for selectively replacing the segment within the scheduled programming content comprising first advertisements with the one or more second advertisements. Applicant submits that none of the prior art cited by the Examiner including Eldering, Dimitrova and/or Herz discloses the aforementioned limitation.

10 Therefore, Applicant respectfully submits that new independent Claim 68 distinguishes over the art of record, including Eldering, Dimitrova and Herz, and thus is in condition for allowance.

New independent Claim 69 corresponds generally to certain aspects of the subject matter of previous independent Claims 1, 9 and 65. Applicant notes that the claim recites (i) generating
15 a list of individual ones of the plurality of user terminals currently receiving the programming content, and (ii) providing at least one advertisement in lieu of at least a portion of the advertising event in the programming content.

Applicant respectfully submits that none of the prior art cited by the Examiner including Eldering, Dimitrova and/or Herz teaches or suggests the aforementioned limitations. Therefore,
20 Applicant respectfully submits that new independent Claim 69 also distinguishes over the art of record, including Eldering, Dimitrova and Herz, and thus is in condition for allowance.

New dependent Claims 70-73 correspond generally to the subject matter of previous dependent Claims 3, 5, 7 and 8, respectively.

Therefore, Applicant submits that no new matter has been added by way of new Claims
25 66-73, and that each distinguishes over the art of record and thus is in condition for allowance.

Other Remarks

Applicant hereby specifically reserves all rights of appeal (including those under the Pre-Appeal Brief Pilot Program), as well as the right to prosecute claims of different scope in another
30 continuation or divisional application.

Application No. : 10/639,070
Filed : August 12, 2003

Applicant notes that any claim cancellations or additions made herein are made solely for the purposes of more clearly and particularly describing and claiming the invention, and not for purposes of overcoming art or for patentability. The Examiner should infer no (i) adoption of a position with respect to patentability, (ii) change in the Applicant's position with respect to any claim or subject matter of the invention, or (iii) acquiescence in any way to any position taken by the Examiner, based on such cancellations or additions.

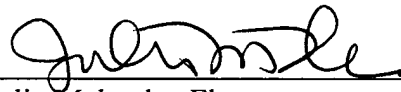
Furthermore, any remarks made with respect to a given claim or claims are limited solely to such claim or claims.

If the Examiner has any questions or comments which may be resolved over the telephone, he is requested to call the undersigned at (858) 675-1670.

Respectfully submitted,

GAZDZINSKI & ASSOCIATES, PC

Dated: March 12, 2009

By: 
Julie Melendez Flores
Registration No. 58,559
Attorney of Record
11440 West Bernardo Court, Suite 375
San Diego, CA 92127
Telephone No.: (858) 675-1670
Facsimile No.: (858) 675-1674